

Remarks

Claims 1-5 and 7-9 were previously pending in the subject application. By this amendment, the applicants have amended claim 1 and have canceled claims 2 and 7-9. No new subject matter has been added by this amendment. Support for this amendment can be found throughout the specification and original claims. Specifically, support can be found on page 3, lines 25-30; page 5, lines 24-31; page 6, lines 1-2; and original claims 2 and 8. Accordingly, claims 1 and 3-5 are now before the Examiner for consideration.

The amendments set forth herein should not be interpreted to indicate that the applicants have agreed with, or acquiesced to, the rejections set forth in the outstanding Office Action. Favorable consideration of the claims now presented, in view of the remarks and amendment set forth herein, is earnestly solicited.

Claims 1-5 and 7-9 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The applicants respectfully traverse this ground of rejection and submit that the teachings of the instant application support the recitation of the genus previously recited in both claims 1 and 7. However, in order to expedite prosecution, the applicants have amended claim 1 to recite the compounds disclosed in original claim 2 and have canceled claims 7-9. Accordingly, the applicants submit that the instant application provides sufficient written description of the presently claimed methods and respectfully request reconsideration and withdrawal of this rejection.

Claims 7-9 have been rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,900,394 to Itabashi *et al.* By this amendment, the applicants have canceled claims 7-9, thereby rendering this rejection moot.

Claims 1, 3-4, 7, and 9 have been rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,753,397 to Nakamura *et al.* The applicants respectfully traverse this ground of rejection because the '397 patent fails to teach each and every element of the claimed methods. As noted above, claims 7 and 9 have been canceled rendering this aspect of the rejection moot. Regarding the rejection of claims 1 and 3-4, the applicants point out that the compounds previously recited in claim 2 have been incorporated into claim 1. The applicants submit that the '397 patent fails to disclose

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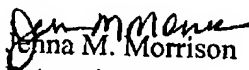
methods of applying any of these compounds because the '397 patent is directed to anti-fouling resins that utilize boron-containing polymers. In order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). The applicants respectfully point out that none of the recited compounds contain a boron moiety and that none of these compounds were explicitly or implicitly taught by the '397 patent. Accordingly, the applicants respectfully request reconsideration and withdrawal of this aspect of the rejection under 35 U.S.C. §102(e).

In view of the foregoing remarks and amendment, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,


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